

**REMARKS****Response to Claim Objections**

Claim 1 was objected to by the Examiner because there appears to be the term -  
- to - missing between "configured" and "extend".

Applicants have amended claim 1 to obviate this objection.

**Response to Claim Rejections Under 35 U.S.C. §103**

Claims 1 and 40-51 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Kieturakis (U.S. Pat. No. 5,794,626) in view of Tihon et al. (U.S. Pat. No. 5,415,656).

The Examiner contends that it would be obvious to combine the teachings of Tihon with the teachings of Kieturakis in order to make the cutting operation easier. However, the cutting mechanism of Tihon would not be functional with respect to Kieturakis. Specifically, the Tihon device is designed for transurethral incision of the prostate. No tissue is removed in the procedure. An incision is made in the patient's urethral canal to eliminate blockage due to benign prostate hyperplasia. There is no lateral or rotational motion of the electrosurgical electrode in the Tihon device, so there is no teaching that would lead those skilled in the art to believe that the electrode of the Tihon device would make tissue removal of a patient's breast by lateral or rotational movement easier than the Kieturakis device. Importantly, the device described by Kieturakis is not designed to sever an entire specimen that surrounds the distal end of the device, but instead severs small pieces of tissue which are aspirated through ports (55) to be removed from the site.

The Tihon patent makes reference in the Background of the Invention of transurethral resection of the prostate (TURP) which relates to removal of prostate

tissue to ameliorate the effects of an enlarged prostate, i.e. benign prostate hyperplasia. If it was obvious to use the device described in the Tihon patent for lateral or rotational movement to remove prostate tissue, surely the inventors would have mentioned it. But they did not.

The Examiner contends that Fig. 12 of Kieturakis describes a device with "encapsulation component 285 configured to extend over the distal shaft portion to encapsulate the isolated tissue specimen and to secure the intact tissue specimen to the distal shaft portion to facilitate removal of the intact tissue specimen from a patient's body along with removal of the instrument". However, as described in column 8, lines 10 to ports 55 are provided to aspirate fluid and excised tissue therethrough which indicates that there is no tissue specimen held against the exterior of the distal shaft portion by members 285. Moreover, with respect to members 285, these members (four) are expanded by centrifugal force and are apparently rotated at relatively high speeds to excise tissue which is capable of being aspirated. There is no single tissue cutting member for cutting a single specimen surrounding the distal shaft portion and no means to hold the intact tissue specimen against the exterior of the distal shaft portion as called for in the present claims.

Applicants believe that the Examiner's rejection is based on speculation which is an improper basis for rejecting applicants' claims. Moreover, the combination of these references fails to teach the features of claim 1 and those claims which depend from claim 1, particularly as amended above.

Claims 29 and 31-33 have been cancelled from this application and added to copending application Serial No. 10/913,747, so the rejection under 35 U.S.C. §103(a) as being unpatentable over Ritchart et al. (U.S. Pat. No. 5,649,547) in view of Tihon et al.

('656) is moot. The claims of the '747 application are directed to methods, so claims 29 and 31-33 appeared to be better suited in that application.

### Conclusion

Applicants believe that the pending claims are directed to patentable subject matter. Further consideration pursuant to the concurrently filed RCE and an early allowance are earnestly solicited.

Respectfully submitted,

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